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PAGE 1/7 * RCVD AT 1/24/2005 1:09:18 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID: * DURATION (mm-ss):02-38

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App. No.	:	09/682,627	Confirmation No. 2280
Applicant	:	Masakazu Karita	
Filed	:	October 1, 2001	
Tech. Cntr./Art Unit	:	3736	
Examiner	:	Brian Scott Szmal	
Docket No.	:	31.001-AG	
Customer No.	:	29453	

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION under C.F.R. § 1.181(a) to Withdraw Holding of Abandonment

Sir:

In response to the Notice of Abandonment of November 22, 2004, Applicant respectfully requests, based on evidence that a reply was timely filed, withdrawal of the holding that the present application is abandoned.

The checkbox next to item 1.(d), "No reply has been received," on the Notice of Abandonment is marked, and the blank next to item 1. is filled in with a date, which seems to allege that Applicant did not reply to "the Office letter mailed on 07 September 2004." Nevertheless, as will now be explained, the Office letter—an Advisory Action—of September 7, 2004 was mailed too late to apprise the Applicant of what he could do to move the prosecution of the present application forward.

Applicant's reply to the Office action of January 21, 2004 was filed, together with a petition for a two-month extension of time, on June 21, 2004, and was therefore timely. As *prima facie* evidence that the reply was timely filed, attached is the first page of Applicant's reply and a one-page Petition for Extension of Time. The Certificate of Mailing or Transmission under 37 C.F.R. § 1.8, appearing on each of the two documents, in the first place serves as *prima facie* evidence that the reply was timely filed on June 21, 2004.

But Applicant need not rely on this evidence exclusively. Both documents have been printed out from the Image File Wrapper, accessed through private PAIR, by the Applicant's undersigned representative. The Image File Wrapper copy of the

App. No. 09/682,627

Abandonment holding withdrawal request dated January 28, 2005

Reply to Notice of November 22, 2004

first page of Applicant's reply is stamped in the upper-right corner with an indication that the reply was received at the Central Fax Center on June 21, 2004. And both documents near the bottom are printed with the text "RCVD AT 6/21/2004 11:38:13 PM [Eastern Daylight Time]."

One further *prima facie* item of evidence readily available in support of Applicant's assertion that his reply to the Office action of January 21, 2004 was timely filed is in the File History on PAIR for this case. The ninth most recent item listed in the File History is "Workflow incoming amendment IFW," and is dated "06-21-2004." The next item chronologically following Applicant's reply—that is, the next item following the formal entry of the reply, "Amendment after Final Rejection," and the granting of the request for extension of time, both dated 06-22-2004—is "Date forwarded to Examiner," and is dated "08-05-2004."

It is respectfully pointed out that **one** month remained before the lapse of the six-month statutory period for replying to the final Office action. MPEP section 714.05, entitled, "Examiner Should Immediately Inspect," states,

Actions by applicant, especially those filed near the end of the period for reply, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the reply within the period.

Yet in response to Applicant's reply of June 21, 2004, an Advisory action was mailed on September 7, 2004—**nearly seven weeks after** the six-month statutory deadline for replying to the final Office action. The timing of this response does not indicate that Applicant's reply of June 21, 2004 was "inspected immediately upon filing to determine whether [it was] completely responsive to the preceding Office action so as to prevent abandonment of the application."

On July 21, 2004, concerned that the six-month statutory period was at its end, Applicant's representative attempted to contact the Examiner in the present application, but was told that he was on vacation, and that filing an appeal or RCE was advisable. Unfortunately, due to the time difference between the U.S. and Japan, where Applicant resides, neither of those suggested options was feasible. MPEP section 714.18, "Entry of Amendments," states:

Every mail delivery should be carefully screened to remove all amendments replying to a final action in which a time period is running against the applicant. Such amendments should be processed within the next 24 hours.

App. No. 09/682,627

Abandonment holding withdrawal request dated January 2⁴, 2005

Reply to Notice of November 22, 2004

The purpose of this procedure is to ensure uniform and prompt treatment by the examiners of all applications where the applicant is awaiting a reply to a proposed amendment after final action. By having all of these applications pass over the supervisory patent examiner's desk, . . . *the supervisory patent examiner will know whether or not the examiner in each application is on extended leave or otherwise incapable of moving the application within the required time periods In cases of this type, the applicant should receive an Office communication in sufficient time to adequately consider his or her next action if the application is not allowed.*

(Emphasis added.)

In sum, it is respectfully submitted that one month constitutes sufficient time to notify an applicant that a reply is inadequate. Nevertheless, the Advisory action indicating that Applicant's reply of June 21, 2004 was found to be inadequate was not mailed until eleven weeks—nearly three months—had elapsed since Applicant's reply was faxed to the art unit to which this application is assigned.

Lastly, it is respectfully asserted that the present petition is timely, because it is being sent within two months from the November 22, 2004 mailing date of the Notice of Abandonment.

Accordingly, withdrawal of the Examiner's holding of abandonment is earnestly requested.

Respectfully submitted,

January 2⁴, 2005

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Attachments